

REMARKS

In response to the Office Action of November 9, 2009, claims 1, 3, 4, 6, 9, 11, 12, 14, 15, 17, 18, 20-25 and 27 have been amended.

The claim amendments are in response to the claim objections and claim rejections under 35 U.S.C. 112. Claim 18 has been amended to correspond to the feature of claim 1. No new matter has been added.

In addition, Applicant respectfully submits that the present Office Action should not have been made final. Section 706.07(a) of the Manual of Patent Examining and Procedure states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the present Office Action, in several of the rejections under 35 U.S.C. 112, the Office introduces new grounds of rejection that were not necessitated by amendment. In the previous Response and Amendment filed on July 31, 2009, Applicant amended claim 1 by simply incorporating the claim 2, previously dependent on claim 1, and making similar amendments to the other independent claims. As it was originally submitted, claim 2 recited:

2. The method as claimed in claim 1, wherein the secure processing point performs the further steps of:

associating a unique device identity with the unique chip identifier;
signing the result of said associating step with a manufacturer private signature key corresponding to a manufacturer public signature key stored in a read-only memory of the device, thereby generating a certificate for the unique device identity;
storing the certificate in the device; and

storing the unique device identity and the certificate in association with the backup data package and the unique chip identifier in the permanent public database.

As can be seen, this language is nearly identical to the language incorporated into claim 1 as amended on July 31, 2009. However, the Office did not reject or object claim 2 in any of the previous six Office Actions for using the term “certificate” in connection with similar language. Furthermore, although claim 2 incorporated the features of claim 1 due to its dependency, and claim 1 also has consistently included “associating the unique chip identifier with the received backup data package,” the phrase in claim 2 of “signing the result of said associating” was never objected to or used to reject the claim under § 112. Under the current reasoning of the Office, claim 2 should have been rejected for the same reasons the Office now applies to reject claim 1, as claim 1 is essentially the most recent claim 2 written in independent form. Amendment to the claim did not necessitate presenting these grounds for rejection, as they could have been presented in several earlier rejections. Therefore, because the Office Action presents rejections that are neither necessitated by amendment or based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c), Applicant requests refund of the RCE enclosed herewith.

Applicant has filed this amendment and response with a Request for Continued Examination (RCE) and the accompanying fee, however, that is not an indication of the Applicant’s belief that the rejection was properly made final, and should the Office agree with Applicant that the rejection should be considered non-final, then Applicant wishes the RCE and fee to be disregarded.

Claim Objections

At page 3 of the Office Action, claims 1, 15, 17 and 27 are objected to for various informalities. Appropriate corrections have been made to the claims to correct the informalities, therefore, it is respectfully requested the objections to the claims be withdrawn

Claim Rejections- 35 U.S.C. 112

At page 4 of the Office Action, claims 1, 3-9, 11-18, 20-25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to the rejections of claims 1, 9, 25 and 27 set forth on pages 5-6, these claims have been amended to recite “signing the associated unique device identity and unique chip identifier” in place of “signing the result of said associating.” Therefore, Applicant respectfully submits that these claims are definite under 35 U.S.C. 112, second paragraph.

With respect to the rejections of claims 3, 11, 18, 20, 22, 24 and 25 set forth on pages 6-7, Applicant has amended these claims to further clarify those features of the claims found indefinite by the Office. It is respectfully submitted that as amended, these claims are sufficiently definite and are in allowable form.

With respect to the rejections of claims 1, 3-9, 11-17, 20-25 and 27 set forth on pages 8-9, Applicant respectfully disagrees. The certificate in the claims is generated by signing the associated unique device identity and unique chip identifier, with a manufacturer private signature key corresponding to a manufacturer public key stored in the personal device. The certificate is stored in the personal device and stored in association with the backup data package and unique chip identifier. This usage in the claim is not indefinite as interpreted by the Office. The specification of the application as filed sets forth on page 6, lines 21-27 (emphasis added):

Preferably, a certificate for the unique device identity associated with a specific device is stored in association with the corresponding backup data package. This has the advantage that the unique device identity may be verified, by means of a public signature verification key stored in a ROM memory of the device, as the authentic device identity during recovery of the personal device.

Therefore, the certificate of the claimed invention is not contrary to the accepted meaning of proving a sender's identity and supplying a public key with which to decrypt a sender's encrypted messages.

For each of the foregoing reasons, it is respectfully submitted that the rejections under 35 U.S.C. 112, second paragraph have been overcome and the claims are in allowable form.

Claim Rejections- 35 U.S.C. 101

At page 6 of the Office Action, claim 27 is rejected under 35 U.S.C. 101 because it is asserted the claimed subject matter is directed to a non-statutory subject matter. As Applicant argued in the response filed on July 31, 2009, there is sufficient structural support for the “means for” language used in claim 27 in the disclosed secure processing point and processing means (see Figure 1 and page 9, line 24 through page 15, line 24). A processor is a sufficient structure to support means plus function terminology under 35 U.S.C. 112, sixth paragraph. *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1059, 22 USPQ2d 1033, 1038 (Fed. Cir. 1992) (citations omitted). Therefore, Applicant respectfully submits that claim 27 is directed to statutory subject matter and is in allowable form.

Claim Rejections- 35 U.S.C. 103

At pages 10-23 claims 1, 3-4, 6, 8-9, 11-12, 14, 16-17, 19-21, 23, 25, and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mauro (US 2002/0147920) in view of Craft et al. (US 2002/0150243, hereinafter Craft) further in view of Chien (U.S. 7,551,913) and further in view of Okimoto et al. (US 6,978,022 B2, hereinafter Okimoto).

With respect to claim 1, it is asserted on page 13 of the Office Action that Craft discloses associating a unique device identity with the unique chip identifier, signing the result of said associating with a manufacturer public signature key stored in a read-only memory of the device, thereby generating a certificate for the unique device identity, and storing the unique device identity and the certificate in association with the backup data package and the unique chip identifier in the public permanent database. Applicant respectfully disagrees.

As argued by Applicant in the previous response dated July 31, 2009, Craft fails to disclose “associating a unique device identity with the unique chip identifier.” Although it is unclear to Applicant what in paragraphs [0015] and [0041] of Craft is being considered to

disclose the “unique device identity” and “unique chip identifier,” the Office states that “CPU chip is equivalent to unique chip identifier.” The Office also states later in the rejection that “a client serial number (216) is equivalent to a unique chip identifier.” Although the CPU chip is assigned a unique client serial number, there is no disclosure of both a unique device identity and a unique chip identifier being associated. The Office states this as well on page 14 of the Office Action, where it is stated “Mauro and Craft are not so clear of disclosing a unique device identity and associating a unique device identity with the unique chip identifier.”

It is also asserted that Chien discloses associating a unique device identity with the unique chip identifier. Applicant respectfully disagrees. The Office suggests that the International Mobile Station Equipment Identity can be used as a device identifier; however, it makes no such assertion regarding what feature disclosed in Chien corresponds to a unique chip identifier. Applicant does not find any reference in Chien to a particular chip, or to a unique chip identifier. A SIM_ID and SIM card are disclosed by Chien, however these are clearly distinct from the unique chip identifier from an integrated circuit chip as set forth in claim 1. Therefore, because Chien does not disclose a unique chip identifier, it also does not disclose associating a unique device identity with a unique chip identifier.

Furthermore, the Office asserts that Craft discloses storing the unique device identity and the certificate in association with the backup data package and the unique chip identifier in the permanent public database, with reference to paragraph [0043], lines 1-6, which states:

The manufacturer of the client CPU chip may then destroy any existing copies of client private key 218, while client serial number 216 and the client public key corresponding to client private key 218 are associatively retained for subsequent use and deployment, such as storing them within the server's client public

Although this passage refers to a public key datastore and the client serial number, which the Office equates to a unique chip identifier, it makes no reference to a unique device identity, a certificate, or a backup data package, nor does it suggest that all of those would be stored in association with each other. It is also acknowledged that Craft does not

disclose a unique device identity, thus it is not clear how Craft discloses storing a unique device identity in a public permanent database. The Office states earlier in the Office Action that Mauro discloses storing the unique device identity and the certificate, however the Office also states that Mauro discloses storing them in secure storage, which is entirely different than a public database. Thus, it is clear that Craft, and any combination of the cited references, fail to disclose storing in the permanent public database, the unique device identity and the certificate in association with the backup data package and the associated unique chip identifier.

Therefore, for the foregoing reasons, it is respectfully submitted that claim 1 is not rendered obvious in view of the cited references, and is in allowable form.

For similar reasons as those presented above with respect to claim 1, it is respectfully submitted that independent claims 9, 18, and 25 are patentable, since each of these claims recite features corresponding to those recited above with respect to claim 1.

Furthermore, dependent claims 3-8, 11-17, and 20-24 are patentable as well, at least in view of their dependency from the independent claims.

In view of the foregoing, it is respectfully submitted that the present application as amended is in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

Dated: February 9, 2010

/Alfred A. Fressola/

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
Bradford Green, Building Five
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676
USPTO Customer No. 004955

Alfred A. Fressola
Attorney for Applicant
Registration No. 27,550